REMARKS

In this Amendment, Applicant has added new Claims 29 – 32 to overcome the rejections and further specify the embodiments of the present invention. It is respectfully submitted that no new matter has been introduced by the amended claims. All claims are now present for examination and favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

REJECTIONS UNDER 35 U.S.C. § 112 FIRST PARAGRAPH:

Claims 19 – 21 and Claims 26 – 28 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to satisfy the enablement requirement and contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is respectfully submitted that the rejection is incorrect because the specification sufficiently describes the present invention as currently amended and enables a person of ordinary skill in the art to practice the claimed invention without undue experimentation.

More specifically, Applicant respectfully submits a further Declaration under 37 C.F.R. 1.132 providing evidence on correct understanding the present invention as well as the various prior art references relied by the Examiner, copy enclosed. Applicant respectfully submits that, in the rejection, Examiner has incorrectly relied on certain statements from the descriptions in Galli et al., Mamalian Leukocytes Contain All the Genetic Information Necessary for the Development of a New Individual, Cloning, Vol. 1, pp. 161-170 (1999) (hereinafter "Clone Paper"), e.g. page 168, col. 1, parag. 1, lines 11 – 17; page 163, col. 1, lines 3 – 7 and lines 11 – 13; and page 166, col. 1, lines 10 – 14. However, as the author of the Clone Paper, the Declarant of the attached Declaration respectfully submits that, the Examiner has misinterpreted these statements and taken these statements out of context. For example, the following sentences appeared before the statement on page 168, col. 1, parag. 1, lines 11 – 17 – "We are confident that much higher ***future*** rates of embryo development and survival to term will be achieved. This is already clear from an analysis of results obtained by us after the optimization of technical

procedures and from ongoing pregnancies" (emphasis added). It is clear to a person of ordinary skill in the art that what the author called optimization steps apply not to the work of the invention of the present patent application, but to future work and ongoing pregnancies. Applicant respectfully submits herein that the calf of the present invention, Galileo, was not produced with these optimization steps mentioned in the Clone Paper. They have been developed ***later*** to improve the efficiency and they deal with cases for which there were ongoing pregnancies as opposed to Galileo, who was already born.

In addition, the Examiner seems to have been persuaded by the work published by Wakayama and Hoechedlinger and therefore doubts that the simple steps set out in the present case are effective. Wakayama and Hoechedlinger are concerned with mice. They fail to give results without taking special steps. In contrast, Exhibit 1 to this Declaration is a paper published by Lee at el in 2003 (Lee et al., Production of Cloned Pigs by Whole-Cell Intracytoplastimic Microinjection, BIOLOGY OF REPRODUCTION 69, pp. 995 – 1001 (2003); copy enclosed to the Declaration). They discussed complicated cloning procedures which went before them, but report success for pigs in a simple, less labor-intensive whole-cell intracytoplasmic injection. No piezostepper was involved. The pig is closer to the bovine of the examples of the present invention than the mouse. All Wakayama and Hoechedlinger show is that the first part of the invention of the present application – first generation cloning – does not work in mice and when Hoechedlinger added the step of embryo complementation he was successful. The present invention leads to success by including the recloning step.

According to MPEP 2164.01(b), as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. § 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987). Furthermore, under MPEP2164.02, a single working example in the specification for a claimed invention is enough to preclude a rejection which states that nothing is enabled since at least that embodiment would be enabled. With the support of the

actual example and the success in the prior art, including those in the cited references, Applicant has provide sufficient disclosure that enable a person of ordinary skill in the art to practice the invention.

Therefore, the rejection under 35 U.S.C. § 112, first paragraph has been overcome. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, is respectfully requested.

REQUEST FOR INTERVIEW:

If after reviewing the present amendment and above evidence and remarks, the Examiner still believes that the application is not allowable or there is any additional issue, Applicant respectfully request for a telephone interview with the Examiner. Such interview may be attended by the inventor(s) of the present invention is necessary. Please contact the undersigned attorney by telephone to set up the interview, if necessary.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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By _____
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Enclosure:
Further Declaration under 37 CFR 1.132